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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,492	12/19/2000	Masahiro Nakada	3169.65005	5702

7590

05/06/2004

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EXAMINER

COFFY, EMMANUEL

ART UNIT

PAPER NUMBER

2157

5

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/741,492

Applicant(s)

NAKADA ET AL.

Examiner

Emmanuel Coffy

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to the application filed on 19 December, 2000. Claims 1-31 are pending. Claims 1-31 are directed to a system, method, and software for an "Electronic Mail System."

### ***Specification***

2. The disclosure is objected to because of the following informalities: on page 2, four lines from the bottom "is finally reaches" should be corrected; on page 17, line 6 third paragraph: "may be signal" is not clear. Appropriate correction is required.

3. The Abstract of the disclosure is objected to because it begins with language that can be implied. Correction is required. See MPEP § 608.01 (b).

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes etc..." In this case the language: "According to an electronic mail system of the present invention" can be implied.

### **Claim Objections**

4. Claims 3, 8-15, and 25 are objected to because of the following minor informalities. Appropriate correction is required.

As per claims 3 and 25, the word "aid" in the body of the claims should be replaced with "said."

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As per claims 8-15, they are dependent claims , which claim dependency on 1, 3, 4 alternatively. A claim that depends from a dependent claim should not be separated by any claim that does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general applicant's sequence will not be changed. See MPEP §608.01(n).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-31 directed to a system, method and software respectively are rejected under 35 USC 102(b) as being anticipated by Woltz et al. (US 5,995, 597).

Claim 1:

An electronic mail system comprising: (See column 3 and column 4).

a determination portion determining whether or not destination limiting information is included in an electronic mail that is planned to be transmitted; (See column 3, lines 62-67).

an identification portion identifying whether or not said electronic mail should be transmitted to destinations included in a header of said electronic mail based on destination limiting information if it is determined by said determination portion that the destination limiting information is included; and (See column 4, lines 3-5).

a transmission portion transmitting said electronic mail only to a destination that is identified by said identification portion as a destination to which said electronic mail should be transmitted. (See column 4 line 13-65). ( At line 22, the reference teaches about a filter which performs the function of this limitation.)

Claim 2:

An electronic mail system according to claim 1, wherein said destination limiting information includes specific information of area to which said electronic mail should be transmitted; (See column 4, lines 28-32).

said identification portion identifies a destination coinciding with said specific information of area among the destinations included in said header as a destination to which said electronic mail should be transmitted; and (See column 4, lines 27-35).

said transmission portion transmits said electronic mail only to the destination identified as a destination to which said electronic mail should be transmitted. (See column 4, lines 27-35).

Claim 3:

An electronic mail system according to claim 2, wherein said specific information of area includes a domain name included in an electronic mail address of the destination to which said electronic mail should be transmitted; (See Column 3, lines 22-28).

said identification portion compares the destinations included in the header with said domain name and identifies an electronic mail including said domain name as a destination, to which said electronic mail should be transmitted; and (See column 3 line 62 through column 4, line 2).

said transmission portion transmits said electronic mail only to the destination identified as a destination to which said electronic mail should be transmitted. (See column 4 lines 13-26).

Claim 4:

An electronic mail system according to claim 1, further comprising:

a second determination portion determining whether or not area designation information is included in said electronic mail; and (See column 7, line 41 through column 8 line 2).

an extraction portion extracting a part designated by the area designation information from a body of said electronic mail if it is determined by said second determination portion that the area designating information is included; (See column 4 lines 27-53).

and wherein said identification portion identifies at least to which of a first area or a second area the destinations included in the header of said electronic mail belongs to; and (See column 2 lines 6-20).

if it is determined that the area designating information is included, said transmission portion transmits said electronic mail to one of the destination belonging to

the first area and the destination belonging to -the second area, and at the same time, transmits another electronic mail in which the part extracted by said extraction portion is included as a body to the other destination. (See column 2 lines 6-20).

Claim 5:

An electronic mail system according to claim 1, wherein, if it is determined by said determination portion that the destination limiting information is not included, said transmission portion transmits said electronic mail to all the destinations included in the header. (See column 6, lines 7-11).

Claim 6:

An electronic mail system according to claim 1, further comprising:

a keeping portion keeping an electronic mail that is planned to be transmitted for a predetermined time; and (See column 6, lines 46-56 and column 5, lines 16-24).

a cancellation portion deleting said electronic mail kept by said keeping portion in accordance with a transmission cancellation instruction obtained before the predetermined time elapses; (See column 6, lines 46-56 and column 5, lines 16-24).

and wherein, if said electronic mail kept by said keeping portion is not deleted before the predetermined time elapses, said transmission portion transmits said electronic mail after the predetermined time elapses. (See column 6, lines 46-56 and column 5, lines 16-24).

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Claim 7:

An electronic mail system according to claim 6, wherein said transmission portion transmits said electronic mail kept by said keeping portion before the predetermined time elapses in accordance with a forcibly transmission instruction.

(See column 6, lines 56-66).

Claim 8:

An electronic mail system according to claim 1, wherein said determination portion, said identification portion and said transmission portion are provided in a mail server for receiving an electronic mail from a mail client or other mail servers, and execute processing for an electronic mail received by said mail server. (See column 3 lines 29-32).

Claim 9:

An electronic mail system according to claim 4, wherein said determination portion, said identification portion, said second determination portion, said extraction portion and said transmission portion are provided in a mail server for receiving an electronic mail from a mail client or other mail servers, and execute processing for an electronic mail received by said mail server. (See column 3, lines 29-39).

Claim 10:

An electronic mail system according to claim 1, wherein said determination portion., said identification portion and said transmission portion are provided in a mail client



transmitting an electronic mail to a mail server, and execute processing for an electronic mail to be prepared by said mail client and transmitted to said mail server. (See column 8, lines 12-24).

Claim 11:

An electronic mail system according to claim 4, wherein said determination portion, said identification portion, said second determination portion, said extraction portion and said transmission portion are provided in a mail client for transmitting an electronic mail to a mail server, and execute processing for an electronic mail to be prepared in said mail client and transmitted to said mail server. (See column 8, lines 12-24).

Claim 12:

An electronic mail system according to claim 1, wherein said destination limiting information is added to a header of said electronic mail transmitted to a mail server in a mail client. (See column 8, lines 12-24 and rejection under claim 1).

Claim 13:

An electronic mail system according to claim 1, wherein said destination limiting information is added to a header of said electronic mail transmitted to a mail server in a mail client, and said area designation information is added to a body of said electronic mail. (See column 7 line 62 through column 8 line 11).

Claim 14:

An electronic mail system according to claim 1, further comprising: a notification portion notifying the destinations to which said electronic mail was not transmitted by said transmission portion. (See column 5, lines 25-40).

Claim 15:

An electronic mail system according to claim 3, wherein said identification portion prepares a first list in which a destination is registered that is identified as a destination to which said electronic mail should be transmitted among the destinations included in the header based on said destination limiting information; and

said transmission portion transmits an electronic mail with the destination registered in said first list only remaining in the header. (See column 3, lines 29-39 and column 6 lines 7-11).

Claim 16:

An electronic mail system according to claim 15, wherein said identification portion prepares a second list in which destinations are registered that are not identified as a destination to which said electronic mail should be transmitted among the destinations included in the header based on said destination limiting information; and

the fact that said electronic mail was not transmitted to the destinations registered in said second list is notified to a sender of said electronic mail. (See column 4, line 64 through column 5, line 8).

Claims 17-31

These claims do not teach or define any significantly new limitation above and beyond claims 1-16 to warrant particular treatment, and therefore are rejected for similar reasons.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Funk et al. (U.S. 5,937,162) teaches "Method and Apparatus for High Volume e-mail delivery."
- Miloslavsky (U.S. 6,128,646) teaches " System for routing electronic mail to best qualified person based on content analysis."
- Takahashi et al. (US 6,442,589) teaches " Method and system for sorting and forwarding electronic messages and other data."
- Stockwell et al. (U.S. 6,072,942) teaches "System and Method of Electronic Mail Filtering Using Interconnected Nodes."
- McCormick et al. (U.S. 6,023,723) teaches "Method and System for Filtering Unwanted Junk E-Mail Utilizing a Plurality of Filtering Mechanisms."
- Eggleston et al. (U.S. 6,101,531) teaches "System for Communicating User-Selected Criteria Filter Prepared at Wireless Client to Communication Server For Filtering Data Transferred from Host to Said Wireless Client."

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (703) 305-0325. The examiner can normally be reached on 8:30 - 5:00 P.M.

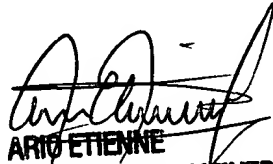
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy  
Patent Examiner  
Art Unit 2157

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April 27, 2004

  
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